

SUBJECT DECISION ON TERMINAL DISCLAIMERS INFORMAL FORM

DATE: 6/10/02
TO EXAMINER: Allen
ROOM _____

APPL. S.N.: 09, 619, 059
ART UNIT: 1631
MAILROOM DATE 4/5/02

AFTER FINAL YES _____ NO ☒ NUMBER OF T.D(S). FILED _____

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next office action to notify applicant about the T.D. If you disagree with my analysis or have questions at all about the acceptability of the T.D., please see me or our Special Program Examiner. THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE.

- ☐ The T.D. is PROPER and has been recorded. (See 14.23).
- ☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24).
- ☐ The recording fee of \$ _____ has not been submitted nor is there any pre authorization in the application file to charge to a deposit account. (See 14.26.07)
- ☐ Application Examiner has not processed T.D. fee. (See fee authorization).
- ☐ The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent. (See 14.26 and 14.26.01).
- ☐ The T.D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting rejection, Rule 321(c). (See 14.27, 14.27.01).
- ☐ It is directed to a particular claims(s), which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted". MPEP 1490. (See 14.26, 14.26.02).
- ☐ The person who signed the terminal disclaimer:
☐ has failed to state his/her capacity to sign for the business entity, (See 14.28).
☐ is not recognized as an officer of the assignee, (See 14.29 and possibly 14.29.01).
- ☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame specified as to where such evidence is recorded in the office. 37 CFR 3.73(b). (See 1140 O.G. 72). **NOTE:** This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30).
- ☐ No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief the title is in the assignee seeking to take action. 37 CFR 3.73(b). (See 1140 O.G. 72) (See 14.31).
- ☐ The T.D. is not signed. (See 14.26, 14.26.3). or 14.26.03 if TD is not signed by all the owners.
- ☐ Attorney not of record in oath/decl, or a separate paper filed appointing a new or associate attorney. (See 14.29.01).
- ☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32).
- ☐ The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.04 or 14.26.05).
- ☐ The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)(For Samples 14.27.04 and 14.27.05)
- ☐ Other: _____

- ☐ Suggestion to request refund of \$ _____. (See 14.35, 14.36).
- ☐ **EXAMINER NOTE: IF APPLICATION IS IN CONDITION FOR ALLOWANCE ANY OF THE ABOVE INFORMALTIES MAY BE FAXED IN TO THE GROUP**

FOR SAMPLE TERMINAL DISCLAIMERS AND CERTIFICATES:

- ☐ Sample of a TD over a pending application and assignee Certificate (See 14.37).
- ☐ Sample of a TD over a prior patent and assignee Certificate (See 14.38).
- ☐ Sample Assignee Certificate under 37 CFR 3.73 (b) (See 14.39)

GENENT.047C1

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : De Young, et al.) Group Art Unit 1631
)
 Appl. No. : 09/619,059)
)
 Filed : July 18, 2000)
)
 For : STABILIZING)
 FORMULATION FOR NGF)
)
 Examiner : M. ALLEN)
)
)

#9
Plunkett
6/10/02

RECEIVED

APR 09 2002

TECH CENTER 1600/2911

TERMINAL DISCLAIMER

Pursuant to 37 C.F.R. 1.321(b) the undersigned attorney of record is empowered to act on behalf of the Assignee, Genentech, Inc., ("Assignee").

In accordance with 37 C.F.R. § 3.73(b), Assignee represents that it is the sole owner of the entire interest of the above-referenced application, which is a continuation of U.S. Serial No. 08/746,073, now U.S. Patent No. 6,090,781, by virtue of an assignment recorded at Reel No. 8487, Frame No. 0625 by the Assignment Branch of the Patent and Trademark Office. The Assignee represents that, to the best of Assignee's knowledge and belief, the whole of this invention, the entire title and interest, is in the Assignee seeking to take action.

Assignee hereby disclaims, except as provided below, the terminal part of any patent granted on the above-referenced application which would extend beyond the expiration date of the full statutory term of U.S. Patent No. 6,090,781, and hereby agrees that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to U.S. Patent No. 6,090,781. This agreement extends to any patent granted on the above-referenced application and shall be binding on its successors or assigns.

04/08/2002 SMINASS1 00000036 09619059

01 FC:117
02 FC:148

920.00 OP
110.00 OP

Serial No: 09/619,059
Filed: July 18, 2000

Assignee does not disclaim any terminal part of any patent granted on the above-referenced application prior to the earlier of the expiration date of the full statutory term of U.S. Patent No. 6,090,781, and that of any patent issuing on the above-identified application in the event that either one later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR § 1.321(a), has all claims canceled by a reexamination certificate, or is otherwise terminated prior to expiration of its statutory term, except for the separation of legal title stated above.

I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity of the application or patent issuing therefrom.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR

Dated: 1 APR 2002

By: 

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